

REMARKS/ARGUMENTS

Claims 32-40 and 42-62 are pending in the application. Claims 32-40 and 42-62 were rejected by the Examiner. The Applicant respectfully traverses the rejections.

The Examiner has rejected claims 51-55 and 62 under 35 U.S.C. §102(e) as anticipated by JP 11-126377 (JP '377). The Applicant respectfully traverses the rejection. The Examiner has made the argument that JP '377 discloses an

"apparatus for bonding two substrates together including a lamination station for applying a first substrate with an adhesive film. The station further includes a pressure roller (51) and the substrate (101) is advanced linearly past the roller (51) during lamination. The substrate adhering station occurs later and includes a pressure pad (208). (See Figures 5 and 14.)"

The Examiner appears to be making the representation that the film of JP '377 is an adhesive film. This is incorrect. JP '377 teaches use of a spray adhesive sprayed onto the substrate by an adhesives coating device 31 and an after-applied plastic film 112 of light transmission nature. (See paras. 0019, 0020, 0026, 0028, 0029, and 0033.) Figures 5 and 14 do not suggest otherwise. Further, Figure 14 clearly depicts that film 112 is disposed on opposing sides of the two-sided disc while adhesive 207 (not a film) achieves the connection between the two substrates 101. As discussed in prior office action responses, the '377 reference simply discloses a method and an apparatus for coating one side of a substrate or for gluing together two substrates to form an optical data carrier. In particular, this reference does not teach or suggest a laminating station for applying a double-sided adhesive film to a substrate. Therefore, the Applicant asserts that the Examiner's use of the JP '377 reference is inappropriate and requests that the rejections be withdrawn.

The Examiner has rejected claims 32-35, 37, 38, 40, 41, 43, 44, 46, and 50 under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,200,402 to Amo in view of JP '377. As discussed above, the JP '377 reference in no way teaches or suggests a laminating station for applying a double-sided adhesive film to a substrate. Further, the Amo reference, as acknowledged by the Examiner on page 3 of the present office action, does not teach moving a substrate during lamination. The Examiner combines the references, stating "It would have been obvious to one having ordinary skill in the art at the time the invention was made based on the teachings of JP '377 that an obvious alternative to having the pressure roller move past the substrate is to have the substrate move past the pressure roller, because the two actions are functionally equivalent alternative expedients."

The Applicant respectfully suggests that the Examiner is engaging in impermissible hindsight. Our case law makes clear that "the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." Dembiczak, 175 F.3d at 999; see also Ruiz, 234 F.3d at 665 (explaining that the temptation to engage in impermissible hindsight is especially strong with seemingly simple mechanical inventions). This is because "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." Dembiczak, 175 F.3d at 999. Therefore, the Federal Circuit has consistently held that a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but some motivation to combine the prior art teachings in the particular

manner claimed. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371 (Fed.Cir.2000) "Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination *in the manner claimed*." (emphasis added) *In re Rouffet*, 149 F.3d 1350, 1357 (Fed.Cir.1998). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination *in the manner claimed*." (emphasis added)).

The Examiner's statement that these are "functional equivalents" would not rise to a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references". There is no showing in either reference that the "functional equivalent" is known or recognized. Therefore, the Examiner has not stated any showing that there is any teaching or motivation to combine the prior art references. As such, the Applicant respectfully requests that the rejections be withdrawn.

The Applicant has attempted to be responsive to all rejections and objections made by the Examiner. If the Examiner believes it would be helpful to discuss the Application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,



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